

## REMARKS

Prior to entry of this amendment, claims 1-20 are pending. Claims 1, 12 and 17 are independent claims. In the Office Action dated December 22, 2003, the Examiner finally rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Bleasdale (U.S. 3,882,770). Applicants respectfully traverse these rejections. Bleasdale discloses a combined shredder and baler for compressing paper.

Previously, in the Amendment dated November 3, 2003, the Applicants amended claim 1 so that the detecting device is located below the cutting device. Claims 12 and 17 were similarly amended so that the detecting device is located below the egress. In the November 3, 2003 Amendment, the Applicants asserted that the claims of the present application are patentable over Bleasdale because Bleasdale disclosed a photosensitive device 24 (Figure 1) located above the cutting rollers 18. As the Applicants noted, the specification of Bleasdale clearly states that the photo-sensitive device is located at an upper part of the chamber but below the ram 15 when the ram is in an uppermost position (col. 2, ll. 19-28). Bleasdale does not teach nor suggest positioning the photo-sensitive device below the cutting rollers. Bleasdale instead actually suggests positioning the photo-sensitive device above the cutting rollers and below the uppermost position of the ram. The photo-sensitive device activates the ram to lower the ram from the uppermost position to compress shredded material while at the same deenergizing the shredder motor. There would be no need to lower the ram to compress the shredded material if the shredded material was at a lower level. Moreover, Bleasdale does not disclose positioning the photo-sensitive device lower than an egress as through which shredded material may be discharged.

The Examiner has rejected these arguments in Paper No. 5 (Office Action date December 22, 2003). However, with respect to independent claims 1 and 17, the Examiner has now issued a § 103(a) rejection in view of Bleasdale rather than a § 102(b) rejection as was issued originally in Paper No. 3 (Office Action date August 1, 2003). The Examiner in essence has rejected claims 1-20 as unpatentable over the Applicants' specification in view of Bleasdale. The Examiner claims that because the Specification of the Applicants' application states that the detecting device can be located in a number of places, the actual placement of the detector is an obvious design choice only.

The Applicants respectfully disagree. The Applicants note that it is the claims, and not the specification, that must be considered when issuing a rejection of claims in view of the prior art. Along these lines, the Applicants respectfully asserts that one may disclose broadly in the Specification and then claim less than what is disclosed and still have patentable claims. The Federal Circuit has held that this practice is allowable. *Johnson & Johnson Assoc. v. R.E. Service Co.*, 285 F.3d 1046, 1054-55 (Fed. Cir. 2002).

In the *Johnson* case, the Applicant had broadly disclosed in the specification that a variety of materials could be used with the invention. *Id.* at 1055. However, the Applicant had amended its claims to claim only one of the varieties of materials disclosed in the specification. *Id.* The claims were nonetheless still patentable. *Id.* at 1054-1033

Here, the Applicants have amended its claims so that the detector is located in one location out of the several locations disclosed in the Specification. As in the *Johnson* case, that the Applicants have amended to claim less what is disclosed in view of the cited prior art does not make the claims obvious in view of the Applicants' Specification. For these reasons, Applicants assert that claims 1-20 are patentable in their present form and that the rejection should be withdrawn.

## CONCLUSION

In conclusion, Applicants respectfully submit that pending claims 1-20 are allowable in their present form, and hereby request allowance of claims 1-20. If any questions arise or issues remain, the Examiner is invited to contact the undersigned at the number listed below in order to expedite disposition of this application.

Respectfully submitted,



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